



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
US 4,52,954	06/02/94	ALLEMAN	

JOHN P. SUTTON  
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LM61/0201

EXAMINER

HUNTER, D

ART UNIT	PAPER NUMBER
2742	# 43

DATE MAILED: 02/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Notice of Allowability</b>	Application No. <b>08/252,984</b>	Applicant(s) <b>Alleman</b>
	Examiner <b>Daniel Hunter</b>	Group Art Unit <b>2742</b>

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

This communication is responsive to the board decision of August 13, 1998

The allowed claim(s) is/are 18-27

The drawings filed on \_\_\_\_\_ are acceptable.

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

Applicant MUST submit NEW FORMAL DRAWINGS

because the originally filed drawings were declared by applicant to be informal.

including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. \_\_\_\_\_.

including changes required by the proposed drawing correction filed on \_\_\_\_\_, which has been approved by the examiner.

including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152
- Interview Summary, PTO-413
- Examiner's Amendment/Comment
- Examiner's Comment Regarding Requirement for Deposit of Biological Material
- Examiner's Statement of Reasons for Allowance

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## REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

The board decision (paper #41) reversed the decision of the Primary Examiner on the grounds that the prior art cited in the case failed to suggest "making use of the incoming direct inward dial number provided by a telephone network or exchange to identify the calling subscriber and to search for a corresponding telephone number for the subscriber." (Page 9) As pointed out by the Board, the IDT references<sup>1</sup> do not provide an indication of the technique used to identify the calling party. Other systems used for international call-back existed at the time the invention was made, although the specifics of how these systems identify the calling party and how the identification is linked to a database to look up the number of the caller to return the call were not found in the references that are available to the examiner.<sup>2</sup>

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<sup>1</sup>The IDT references were Business Week articles entitled "Rome to Bonn Via New Jersey" (April 13, 1992) and "How Overseas Callers Can Get Stateside Rates" (December 2, 1991).

<sup>2</sup>US Patents cited in the prosecution history and relied upon by the examiner in the Examiner's Answer include Kahn et al. (4,086,438), Billinger et al. (4,769,834) and Srinivasan (5,185,782). Additional references pertinent to the invention also include US Patents to Curtin (4,672,660) and Riskin (4,757,267); International Call-Back Book, An Insider's View, Gene Retske; and Telephony Journal, "You Can't Beat The Price", vol 228, No 12.

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A variety of references teach all of the elements of the claimed invention with the exception of the limitation described in the board decision, *supra*. Kahn et al. (4,086,438) teaches a system which enables a caller to cause the system to call them at an entered telephone number so that additional calls could be placed through the system. In Kahn et al., the call arrives on a regular telephone line instead of a trunk using DID capability and the caller enters a code to permit access to the system. The use of direct inward dialing to assist in the identification of a caller is taught by Curtin (4,672,660); however, it would not have been obvious to modify the invention of Kahn et al. with this capability since Kahn et al. uses a single line system and does not teach that it is necessary or desirable to identify any particular caller. Additionally, linking the DID to a database to perform caller number lookup is not provided in Curtin. The IDT references previously relied upon are silent on the issue of how the caller is identified and the subsequent steps that were taken to obtain the callers' telephone number. As indicated in the Board decision, a number of different techniques were known at the time of the invention, and have been subsequently used in the international call-back industry to accomplish the task, including ANI, Caller ID, DID, and password.

In February, 1995, Flatiron Publishing, Inc., published a book titled The International Callback Book, An Insider's View. This book alleges that Gateway USA used a Direct Inward Dial (DID) technique to identify the calling customer at some time that may have been prior to the filing date of this application. (Page 16) While this document provides an indication that DID had been used prior to the filing of this application, no additional references that qualify as prior art

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under 35 USC 102 have been located to support these allegations. As such, the necessary element that was missing to support a rejection under 35 USC 102 or 103 is not available. The examiner recognizes that material that is not technically prior art can be relied upon as evidence of the skill level of one of ordinary skill in the art even though the document was published at a later date. *Ex parte Erlich*, 22 USPQ2d 1463 (BPAI 1992). Additionally, the examiner recognizes that the sale of items more than one year prior to the filing date constitutes prior art, even if the evidence is published or made available at a later date. *In re Epstein*, 32 F.3d 1559 (CAFC 1994). However, The International Callback Book article does not provide a clear indication that the missing element, "making use of the incoming direct inward dial number provided by a telephone network or exchange to identify the calling subscriber and to search for a corresponding telephone number for the subscriber", is completely embodied in the Gateway USA device, although it does appear that the device may have been in existence for more than one year before the filing of the application ("A few years later in 1991 and 1992, ...").

Therefore, it would not have been obvious to one of ordinary skill in the art to modify the IDT device, or to modify the Gateway USA device as needed, as the missing elements are not provided in the prior art of record.

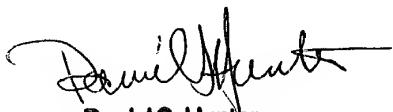
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Hunter whose telephone number is (703)308-6732. The examiner can be normally reached from 7:30 am to 4:00 pm Monday through Friday. If the examiner is unavailable, the examiner's supervisor, Krista Zele, can be reached at (703) 305-4701.

  
Daniel S. Hunter  
Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

LMC170202

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BEST AVAILABLE COPY

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/252,984	06/02/94	010	HUNTER, D	2742 08/01/94
First Named Applicant	ALLEMAN,		JAMES H.	

TITLE OF INVENTION INTERACTIVE TELEPHONE SYSTEM FOR OPTIMIZING SERVICE ECONOMY

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEES DUE	DATE DUE
	379-205.000	050	UTILITY	YES	\$605.00	05/03/95

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT.  
PROSECUTION ON THE MERITS IS CLOSED.**

**THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS  
APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.**

**HOW TO RESPOND TO THIS NOTICE:**

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give application number and batch number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

If the SMALL ENTITY is shown as NO:

A. Pay FEE DUE shown above, or

B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

**IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

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